

Att'y Dkt. No.: 10990105-1
USSN: 09/302,898

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow claims 1-18, 20-48, the only claims pending and currently under examination following entry of the above amendments.

It is noted that Claims 1-17 and 20-45 have been found allowable, and that claims 47 and 48 have been indicated as being allowable if rewritten in independent form.

Claim 18 has been amended to indicate that when the identified error is first level error, a first level error is associated with the array. Support for this amendment is found at least at page 20 of the specification, where a description is made of first level errors. Claim 47 has been amended to correct a typographical error. As no new matter is added by the above amendments, their entry by the Examiner is respectfully requested.

Claim rejection under 35 U.S.C. § 112, 1st ¶

Claim 18 has been rejected under 35 U.S.C. § 112, 1st ¶ as failing to comply with the written description requirement. In making this rejection, the Examiner asserts that the previous amendment to Claim 18 which introduced the phrase

"(f) forwarding the array and medium to a remote user"

represents NEW MATTER. This amendment is asserted to be NEW MATTER because the Examiner is not yet convinced of the adequacy of the portion of the specification cited to support the amendment. In explaining why the cited portion of the specification does not clearly support the amendment, the Examiner states: "Consideration of said citation has failed to reveal any written basis for the forwarding of an array medium to remote user. What is forwarded via the package therein is not defined. Thus, the amendment to claim 18 is NEW MATTER."

The portion of the specification cited in the previous response to support the amendment reads as follows:

Atty Dkt. No.: 10990105-1
USSN: 09/302,898

When a remote customer receives a package such as **package 340**, the **received section 15** may be exposed to a sample (which may be labeled) in a known manner under appropriate conditions (such as hybridizing conditions).

This sentence must be read in conjunction with the teachings of other parts of the specification, and specifically those parts that discuss the contents of **package 340**. Specifically, this section must be read in conjunction with the teaching of the specification at page 20, lines 16 to 31, which read:

In the case of first level errors for one or more arrays on a **substrate 14**, processor 140 can cause an identification of these errors to be written by drive 320 onto **portable storage medium 324**. Alternatively or additionally, an identification of these errors can be written by printer 350 onto a medium in the form of a **paper sheet 354** in either machine readable characters (for example, bar codes) or in human readable characters (for example, alphanumeric or other characters). These identifications may contain the actual data specifying the spot error types and their magnitudes. Alternatively, these identifications may be unique arbitrary identifications generated by processor 140 and stored in memory 141 in association with the actual error map, so that the actual error map can be retrieved (such as from a remote computer over a communication line, as mentioned below) from memory 141 by an end user of the arrays using the identifications. **The medium on which the identifications are written, can be physically associated with the corresponding arrays on a section such as section 15, by packaging each array and any such medium together in a single package 340.**

When the sentence at page 25, line 8 is read in conjunction with the above section from page 20, it is clear that the package may include both the array and a medium. This teaching is further illustrated in Figure 4, where an array 15 and 324 are shown being physically associated in package 340 (see arrows) for forwarding on to remote user where remote reader 162 is located.

Atty Dkt. No.: 10990105-1
USSN: 09/302,898

In view of the above, it is respectfully submitted that the previous amendment to Claim 18 introducing the phrase "(f) forwarding the array and medium to a remote user" does not represent new matter. As such, the rejection of claim 18 under 35 U.S.C. § 112, 1st ¶ may be withdrawn.

Claim rejections under 35 U.S.C. § 103

Claims 18 and 46 remain rejected under 35 U.S.C. § 103(a) as assertedly being obvious over Baldeschwieler in view of Weber, since the Applicants' previous amendment to Claim 18 was considered New Matter and therefore not considered.

With respect to the rejection of claim 18, it is believed that this rejection is based on the Examiner's equation of the "medium" of step (f) with the actual fabrication device, in view of the statement at the bottom of page 5 of the office action where it is stated that the "system descriptions in Weber et al. are reasonably mediums for the signals recorded thereon as thus physically associated with the printed substrate..."

Claim 18, as amended, now specifies that the fabricated array and medium are forwarded to a remote user, which amendment clarifies that the medium is separate from the array fabrication device. It is believed that claim 18 is clearly not obvious over the cited references.

With respect to claim 46, it is respectfully submitted that one of skill in the art would not be motivated to modify Baldeschwieler with the teaching of Weber to arrive at the claimed invention because the present invention solves a problem not appreciated by either Baldeschwieler or Weber.

Specifically, the present invention is directed to the problem in which the array pattern of a given array is different from the target array pattern according to which the array was fabricated due to errors arising during the manufacture process, which can cause issues with the usability of the array.

Atty Dkt. No.: 10990105-1
USSN: 09/302,898

As such, it is desirable during the manufacture of an array to ensure that any discrepancy between an actual array pattern and the target array pattern according to which it was fabricated be kept at a minimum. Such is desirable so that, during use, one can know precisely where features of the array are located.

Baldeschwieler provides no teaching or suggestion, and therefore has no appreciation, of the problems that may arise from discrepancies between an actual and target drive pattern. Therefore, one using Baldeschwieler's teachings as a guide for producing arrays would not be motivated to go the extra step of correcting for errors so as to reduce discrepancies between the actual and target array pattern, because one would not appreciate that such discrepancies, if present, would have any effect on the usability of the array. Accordingly, one would not be motivated to combine the teachings of Baldeschwieler with Weber to arrive at the invention of these claims because there would be no need to do so, as the specific problem that is solved by the invention was not appreciated by the prior art.

Accordingly, it is respectfully submitted that Claims 18 and 46 are not obvious under 35 U.S.C. § 103(a) over Baldeschwieler in view of Weber and that this rejection may be withdrawn.

The Examiner is thanked for the acknowledgement of the allowability of claims 1-17 and 20-45.

Atty Dkt. No.: 10990105-1
USSN: 09/302,898

CONCLUSION

The Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Gordon Stewart at (650) 485 2386. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

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